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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,998	06/01/2001	Anthony M. Mazany	200EP040	3656

7590

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GEORGE W. MOXON II ESQUIRE
ROETZEL & ANDRESS
222 SOUTH MAIN STREET
AKRON, OH 44308

EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/871,988

Applicant(s)

SUBRAMANIAN ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 52-59 and 67-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 and 60-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicant's election with traverse of Group I, claims 1-51 in Paper No. 8 is acknowledged. After further consideration, Groups I and III have been combined. Both represent similar alkali silicate compositions. However, the examiner maintains that the restriction between the methods of making and product formed are patentably distinct. The glass is also patentably distinct from the other groups for the proper reasons provided.

The traversal is on the ground(s) that the only difference between Group I and III is in slurry form. This is not found persuasive because Group I also contains water and can thus be considered a slurry. Further, claims 52-59 refers to a method of making and the examiner has shown that other methods are available to make an alkali silicate composition which has been untraversed by applicants. Group IV is also a method of making the composition can be made by other means. Applicants have not traversed that there are other possible methods of making an alkali silicate composition. As for the glass, applicants are silent regarding the examiner's proper holding for restriction that this glass (ie the intermediate product) can be used in a multitude of different ways provided in the reasons for untraversed reasons for restriction. Whether the compositions require a glass is irrelevant. The standard is whether there is an intermediate/final product relationship (which there is) as set forth by the MPEP.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-51 and 60-66 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jin '699B1 or Zaretsky et al. '619.

Jin et al. teach a binder composition comprising alkali silicate, glass, and water and would appear to anticipate the instant invention. (see claims).

Zaretsky et al. also teach a binder composition comprising alkali silicate, glass, and water and would appear to anticipate the instant invention (see claims).

Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art.

Claims 1-51 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

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The terms "reaction product of an alkali silicate and /or alkali silicate precursors" ^{is indefinite.} 1
What is the reaction between to achieve these materials? It would appear applicants should include dependent claim limitations to particularly point out and distinctly claim their invention.

The terms "reactive glass" would appear indefinite in claim 1 and throughout the claims. What glass is reactive versus one that is allegedly inert? Are not all glasses reactive to some extent? How do applicants define a reactive glass versus a non-reactive glass if there is such a thing?

The term "microsilica" is not spelled correctly in claim 5. Also, in claim 5, there is no difference seen between fumed silica and silica fume. Applicants should delete one of these terms since they are the same.

The use of parentheses is improper in the claims. In claim 7, applicants may consider deleting K and Na and inserting the word potassium and sodium.

The use of parentheses in claim 8 is improper. Applicants should delete the parentheses.

The terms "regular particles" and "irregular particles" would appear indefinite in claim 45. What is a regular or irregular particle and how are they different?

The use of parentheses in claims 50 and 51 is improper.

The use of parentheses in claim 49 is indefinite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-

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1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni
Primary Examiner
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